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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,094	12/03/2003	Floyd Randolph Simonds	2001-IP-005937 UIC1 USA	8762
32376	7590	11/01/2005	EXAMINER	
LAWRENCE R. YOUST DANAMRAJ & YOUST, P.C. 5910 NORTH CENTRAL EXPRESSWAY SUITE 1450 DALLAS, TX 75206			BOMAR, THOMAS S	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,094

Applicant(s)

SIMONDS ET AL.

Examiner

Shane Bomar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
4a) Of the above claim(s) 3,4,14-22,32 and 36 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,2,5-13,23-31,33-35 and 37-41 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/22/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Species I - embodied by Figures 2-6 and encompasses a method of completing a wellbore while drilling that comprises an expandable sand screen.
- Species II - embodied by Figures 7-10 and encompasses a method of completing a wellbore while drilling that comprises a sand control screen and a gravel packing assembly, wherein no expansion of any of the components occurs.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 7-13, 34, 35, and 38-41 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Lawrence Youst on 10/18/05 a provisional election was made without traverse to prosecute the invention of Species II, claims 5, 6, 23-31, 33, and 37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 4, 14-22, 32, and 36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

4. The disclosure is objected to because of the following informalities: the Cross-reference section should be updated to show that 10/196,635 is now abandoned and that 10/342,545 is now US patent 6,766,862.

Appropriate correction is required.

Claim Objections

5. Claims 6, 23, and 37 are objected to because of the following informalities: the recitations of "the gravel packing apparatus" should be replaced with --the gravel packing assembly-- to remain consistent with the previous recitations in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 5-13, 23-31, 33-35, and 37-41 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 5,667,023 to Harrell et al.

Regarding claims 1, 2, 5-8, 11, 12, 23-26, 29, 30, 33-35, 37-39, and 41, Harrell et al disclose a method of completing a wellbore while drilling, and associated apparatus, comprising the steps of: disposing a drill bit 54 on an end of a drill string; positioning a completion assembly 30 including a sand control screen and a gravel packing apparatus around a section of the drill string; establishing a fluid seal 92 and a rotatable coupling between the completion assembly and the drill string to prevent fluid migration and torque transfer therebetween; extending the wellbore by rotating the drill bit and advancing the drill string beyond the end of a casing in the wellbore without rotating the completion assembly; ceasing the advancement of the drill string when the completion assembly has reached a desired depth; supportably coupling the completion

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assembly to the casing with a suspension tool 82; disconnecting the drill string from the drill bit; retrieving the drill string to the surface leaving the completion assembly and the drill bit downhole; and gravel packing the wellbore around the sand control screen and the gravel packing apparatus (see Figs. 5, 6, 9, and 10; col. 9, line 38 through col. 10, line 52; and col. 11, line 29 through col. 12, line 67).

Regarding claims 9, 10, 27, 28, and 40, a downhole motor 60/220 rotates the drill bit (see Figs. 5, 6, 9, and 10), while, during steering operations, the drill bit can be rotated by string 20 (see, for example, col. 9, lines 21-23).

Regarding claims 13 and 31, a production tubing is installed relative to the completion assembly (see, for example, col. 10, lines 4-7).

Response to Arguments

8. Applicant's arguments with respect to the claims filed in application 10/196,635 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mason et al teach an expandable sand screen for placement while drilling. Mocivnik et al teach the placement of a sand screen while drilling. Frank et al, Saugler, and Smith et al teach drilling while completing a well wherein the casing is not rotated during drilling. Hudson teaches drilling while completing a well, but both the drill and completion assembly rotates. Vail et al teach drilling while completing a well, but the drill string and the completion assembly


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are the same unit, therefore the completion assembly cannot surround the drill string. Chitwood et al teach a drilling and casing device of interest. Donovan et al teach a method and apparatus similar to that of Harrell et al. Hill et al teach a method of gravel packing of particular interest.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 6:30am to 4:00pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David J. Bagnell
Supervisory Patent Examiner
Art Unit 3672

tsb


October 19, 2005